

REMARKS

Claims 6-10 and 17-19 are pending in this application. By this amendment, claim 17 has been amended to correct its dependency from canceled claim 1 to allowable claim 6.

Reconsideration of this application, as amended, is respectfully requested.

Allowed Claims

Applicants acknowledge with appreciation the allowance of claims 6-10 and 19.

Claim Objection

Claim 17 is objected to because it depends from a canceled claim. Applicants have amended claim 17 to depend from allowed claim 6.

Accordingly, reconsideration and withdrawal of this claimed invention are respectfully requested.

Rejections under 35 U.S.C. § 103

Claims 18 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over GB 2 288 126 to Nakata et al. ("Nakata"). This rejection is respectfully traversed.

Applicants respectfully submit that claim 18 patentably defines over Nakata because Nakata fails to disclose, suggest, or otherwise render obvious the claimed combination of features, including an annular plate shaped first tooth-hardening member having a top surface provided with a plurality of projections, wherein the plate lies in a plane; and oval plate shaped second tooth-hardening members having a top surface provided with a plurality of projections; wherein the oval plate shaped second tooth-hardening members are arranged at an outer

from one another and extended from the periphery of the annular plate shaped first tooth hardening member in the plane in which the annular plate shaped first tooth lies, the top surface of the annular plate shaped first tooth-hardening member and the top surface of the oval plate shaped second tooth-hardening members are formed of respective materials which have hardnesses different from each other, and the top surface of the annular plate shaped first tooth-hardening member is harder than the top surface of the oval plate shaped second tooth-hardening members, and both the first and second tooth-hardening members are adapted to be chewed by the infant, as claimed.

The Office Action indicates that the embodiment of Nakata's Fig. 6 (which the embodiment is also shown in Figs. 5 and 7) discloses a first annular plate shaped first tooth-hardening member (42). Applicants respectfully disagree with this conclusion and submit that the Nakata's element 42 is not plate shaped, but is tubular shaped so that it can contain plural multicolored balls 47. Note, in this regard, that the tubular shape is disclosed on page 8, lines 25-30 and, thus, oval grip 42 is tubular shaped, not plate shaped, as claimed.

Applicants also respectfully submit that teething elements 43 and 44 of Nakata are not oval shaped, but are explicitly disclosed as being "sector shaped" on page 8, lines 20-24 and Fig. 5. In an attempt to remedy this shortcoming of the embodiment of Figs. 5-7 of Nakata, the Office Action turns to page 3, line 17 of Nakata, which discusses a different embodiment, i.e., the embodiment of Fig. 1, which is said to have a "generally oval" teething element 11, and the Office Action concludes that it would be obvious to use an oval shaped teething element instead of the Fig. 5 wedge shaped teething element 42 or 43.

Applicants respectfully disagree with this conclusion for a number of reasons.

Firstly, Applicants respectfully submit that visual inspection of the shape of teething element 11, in Fig. 1 of Nakata, reveals that it is not oval. Rather, it is arcuate. Thus, even if one of ordinary skill in the art were properly motivated to use the arcuate shaped teething element 11 in Fig. 5, the so modified version of Fig. 5 would still not disclose, suggest, or otherwise render obvious the claimed invention.

Secondly, in Nakata's Figs. 5-7 embodiment, Applicants respectfully submit that it is readily apparent to one of ordinary skill in the art that the teething elements 43 and 44 are sector shaped (actually, wedge-shaped) as a construction feature, and that the Office Action does not provide objective factual evidence that one of ordinary skill in the art would be properly motivated to do away with the wedge shaped teething elements of Figs. 5-7 and replace them with the arcuate teething element 11 of Figs. 1-2 embodiment, because an entirely different fastening structure would have to be designed to serve as an alternative to the eliminated wedge shaped construction feature of teething elements 43 and 44.

Thirdly, teething element 43 in Nakata is not located at an outer peripheral edge of teething element 44, or *vice versa*. In fact, teething elements 42 and 43 are located at an outer edge of oval grip 42, which is not disclosed as a teething element.

Apparently, recognizing the weakness of this rejection, the Office Action turns to *In re Dailey*, 357 F.2d 669, 149 USPQ 46 (CCPA 1966) to bolster the rejection, and relies on a *per se* rule that changes in shape are obvious. As stated by the Federal Circuit in *In re Ochiai*, 71 F.3d 1565, 1572, 37 USPQ2d 1127, 1133 (Fed. Cir. 1995), “reliance on *per se* rules of obviousness is legally incorrect and must cease.” Moreover, *In re Dailey*, 149 USPQ 47 actually did not deal with tooth-hardening devices and therefore, could not have possibly held that absent persuasive evidence, the particular configuration of the claimed tooth hardening members is significant.

Actually, all that the Court of Customs and Patent Appeals stated, in this regard, in that case was:

Claim 27, while defining no particular nipple opening structure, recites the configuration of the top and bottom sections of the container as that of "a portion of a sphere less than a hemisphere." In claim 28, the central angle of those spherical portions is about 80°.

* * * * *

As noted above, Matzen discloses that the flexible portion of his container is drawn into the rigid top portion, filling the space thereof. Appellants have presented no argument which convinces us that the particular configuration of their container is significant or is anything more than one of numerous configurations a person of ordinary skill in the art would find obvious for the purpose of providing mating surfaces in the collapsed container of Matzen. *See Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459.

Turning to the facts at hand, the Office Action provides no objective factual evidence that one of ordinary skill in the art would be properly motivated to turn to the "*In re Dailey*" case to modify a wedge-shaped teething element with an arcuate shaped element that appears to be missing a wedge-shaped portion that would fit into the Fig. 5 embodiment of Nakata in an operative manner. Another way of saying this is that the arcuate-shaped teething element 11 of the Figs. 1-2 embodiment of Nakata does not appear to have physical characteristics to be integrally attached to the Fig. 5 embodiment of Nakata in an operative manner.

In this regard, Applicants note that the shape of element 11 is designed to work with a u-shaped grip having two ends that are attached to two ends of element 11 using separate, specific fasteners, which would appear to be needed to attach element 11 to the embodiment of Figs. 5-7. However, the Office Action does not establish by objective factual evidence that one of ordinary skill in the art would be properly motivated to significantly and fundamentally alter the construction of the Figs. 5-7 embodiment to provide such fasteners to hold the non-wedge shaped teething element 11. It is significant to note that if the fasteners 12a and 12b were inserted in the oval grip

42 of Figs. 5-7, then the only way that they could physically fasten arcuate teething elements 11 to the oval teething ring would be to modify the arcuate teething elements 11 so that they become wedge-shaped and then, the arcuate teething elements 11 would no longer be arcuate, let alone oval, as claimed.

Also, if arcuate teething elements 11 of Fig. 1 of Nakata were inserted into the oval grip of Figs. 5-7 of Nakata, there would not be enough area left for an infant or child to effectively teethe and, as noted above, oval grip 42 of Nakata is not disclosed as a teething element.

Additionally, the mere citation of any case as a basis for rejecting process claims that differ from the prior art by their use of different starting materials is improper, as it sidesteps the fact-intensive inquiry mandated by Section 103. In other words, there are no "*In re Dailey* obviousness rejections," but rather only Section 103 obviousness rejections.

As pointed out in *In re Ochiai*, 37 USPQ2d 1127 (Fed. Cir. 1995), this method of analysis is founded on legal error because it substitutes supposed *per se* rules for the particularized inquiry required by Section 103. It necessarily produces erroneous results.

Existing case law is grounded on the same analytic principle, namely, that Section 103 requires a fact-intensive comparison of the claimed process with the prior art rather than the mechanical application of one or another *per se* rule. The Court went on to state that the controlling law is in Section 103 of the statute which must be applied to the facts of each, and that the function of the Office and the Courts is to apply, in each case, Section 103 as written to the facts of disputed issues, not to generalize or make rules for other cases which are unforeseeable. The case law presents applications of a unitary legal regime to different claims and fields of art to yield particularized results. Moreover, the Court has consistently cautioned the Bar not to generalize or make rules for other cases.

The Court went on to state that the use of *per se* rules, while undoubtedly less laborious than a searching comparison of the claimed invention -- including all its limitations -- with the teachings of the prior art, flouts Section 103 and the fundamental case law applying it. *Per se* rules that eliminate the need for fact-specific analysis of claims and prior art may be administratively convenient for PTO Examiners and the Board. Indeed, they have been sanctioned by the Board as well. But reliance on *per se* rules of obviousness is legally incorrect and must cease. Any such administrative convenience is simply inconsistent with Section 103, which, according to *Graham* and its progeny, entitles an Applicant to issuance of an otherwise proper patent unless the PTO establishes that the invention, *as claimed*, in the application is obvious over cited prior art, based on the specific comparison of that prior art with claim limitations.

The Court held that its precedents do not establish any *per se* rules of obviousness, just as those precedents themselves expressly declined to create such “*per se*” rules.

Thus, this use of case law on which to base an obviousness-type rejection is completely improper. The “*Dailey*” decision concerned the particular placement of a contact in a conductivity measurement device, which the Office Action fails to demonstrate has anything to do with providing a recess at all, let alone for preventing stress concentration, and for locating it at the claimed location.

Accordingly, the Office Action fails to make out a *prima facie* case of anticipation of claim 18 by Nakata.

Thus, Applicants respectfully request that this rejection of claim 18 be withdrawn.

CONCLUSION

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone Robert J. Webster, Registration No. 46, 472, at (703) 205-8000, in the Washington, D.C. area.

Prompt and favorable consideration of this Amendment is respectfully requested.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

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